

REMARKS

Claims 54-69 are pending and at issue. Applicants appreciate the Examiner's indication that claims 61 and 64-69 recite subject matter that is allowable over the cited prior art. Based upon the following comments, Applicants respectfully request reconsideration and allowance of all pending claims.

Before addressing the specifics of the Office action, please note that claim 56 is amended herein to correct a typographical error. Specifically, the word "and" has been deleted and replaced with the word "an". No new matter is introduced by this amendment, nor does it raise any new issues of patentability. Accordingly, entry and consideration of this amendment are respectfully requested.

Turning to the Office action, the drawings stand objected to for allegedly failing to show every feature of the invention specified in the claims. Applicants respectfully traverse the objection to the drawings.

Specifically, the drawings as filed clearly illustrate each feature that the Office action purports to be missing. First, the Office action asserts that the drawings fail to show "the base and outer membrane" integrally formed from a single piece of material. Figs. 5-9, and specifically Figs. 7A and 7B, show a base and outer membrane formed from a single piece of material. The description which accompanies these figures, which is found at page 23, lines 16-24, further indicates that the "an outer membrane 306" and "an inner base 308" are formed from a long tubular member 312 (Fig. 7B). Accordingly, the drawings as filed clearly show a base and outer membrane integrally formed from a single piece of material (i.e., the tubular member 312), and therefore this ground for objecting to the drawings must be withdrawn.

Next, the Office action asserts that the drawings fail to show "the first and second members" being bonded together. Again, Figs. 5-9, and particularly Fig. 7A and its accompanying description, clearly illustrates such structure. Specifically, the ends 320, 322 of the smaller and larger diameter portions 316, 314 are aligned as shown at the left-hand portion of Fig. 7A. As specifically disclosed at page 24, lines 23-25, the ends are "sealed by heat or adhesive." Applicants submit that sealing by heat or adhesive are two examples of bonding, and therefore Fig. 7A clearly illustrates first and second members bonded together. Consequently, this ground for objecting to the drawings must be withdrawn.

Finally, the Office action asserts that the drawings fail to show a "180 degree fold." Once again, Figs. 5-9, and specifically Fig. 7A, illustrates the claimed structure. The right-hand portion of Fig. 7A illustrates the tubular member 312 folded over on itself to form the 180 degree fold. The description at page 23, line 23, to page 24, lines 14, also makes numerous references to the 180 degree fold shown in Fig. 7A. Accordingly, this ground for objecting to the drawings must be withdrawn.

The Office action also rejects claims 55-58 and 64-69 under 35 U.S.C. 112, second paragraph as indefinite. As a general response, Applicants assert that the claims as submitted are sufficiently clear and particular, and therefore the indefiniteness rejection must be withdrawn.

More specifically, the Office action asserts that it is unclear "how the first and second members are bonded together" in claim 60 and "throughout the claims." First, Applicants submit that 35 U.S.C. 112, second paragraph, does not require applicant to specifically claim "how" claimed structure is formed. Instead, 35 U.S.C. 112, second paragraph, addresses whether claim language is definite when analyzed in light of:

- (A) The content of the particular application disclosure;
 - (B) The teachings of the prior art; and
 - (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.
- (MPEP Section 2173.02)

Accordingly, "how" the first and second members are bonded is irrelevant to a proper analysis under 35 U.S.C. 112, second paragraph. Instead, Applicants submit that the specification at page 24, lines 23-25, describes examples of how the members may be bonded. Furthermore, the claimed element of bonding first and second members is sufficiently clear and would be well understood by one of ordinary skill in the art. Consequently, this ground for rejecting the claims as indefinite must be withdrawn.

The Office action also asserts that "it is unclear how the first and second members can be formed of one piece of material" as specified in claim 55 and "throughout the claims." Again, a proper inquiry under 35 U.S.C. 112, second paragraph, focuses on whether a claimed element is sufficiently clear to one of ordinary skill in the art, not on "how" a claimed element is formed. Again, Applicants refer to the specification at page 23, lines 16-18, as well as Figs. 7A and 7B, which describe a tubular member formed into an inner base

and an outer membrane. One of ordinary skill in the art would understand the scope of the language used, particularly in light of the specification, and therefore this ground for rejecting the claims as indefinite must be withdrawn.

Finally, the Office action asserts that it is unclear how the tubular member is folded to form the 180 degree fold, as specified in claims 57 and 64, as well as “throughout the claims.” Again, a proper inquiry under 35 U.S.C. 112, second paragraph, would address whether the claimed element is sufficiently clear and definite, rather than “how” that claimed element is formed. The language of claim 57, which specifies “a 180 degree fold”, is inherently clear and distinct, as is the language of claim 64 specifying the folding step. Accordingly, this ground of rejection must be withdrawn.

Turning to the rejection on the art, claims 54, 59, and 63 stand rejected under 35 U.S.C. 102(b) as anticipated by McCall (U.S. Patent No. 5,000,599). Applicants respectfully traverse this ground of rejection.

Claim 54, as well as claims 55-63 depending directly or indirectly thereon, specify a writing instrument including a deformable sleeve. The sleeve includes a tubular base having a first diameter and an outer membrane having a second diameter larger than the first diameter. The ends of the base and membrane engage to define a cavity therebetween. A sealable passageway is formed between adjacent ends of the tubular base and outer membrane and fluidly communicates with the cavity. A formable material is disposed in the cavity. It is not seen that McCall discloses or suggests each element of independent claim 54.

Specifically, McCall fails to disclose or suggest the sealable passageway between adjacent ends of the base and membrane. McCall generally asserts that instead of the permanently mounted embodiment specifically disclosed therein, its grip may be “an enlarged sleeve defining a bladder with the deformable substance therein, said sleeve being removably mountable onto any selected implement.” At no point does McCall disclose or suggest that the proposed bladder could have a “sealable passageway formed between adjacent ends of [a] tubular base and outer membrane that communicates with [a] cavity” as specified in claim 54. Accordingly, McCall fails to disclose or suggest each element of claim 54, and therefore the anticipation rejection of claims 54, 59, and 63 must be withdrawn.

In making the anticipation rejection, the Office action argues that the “respective ends of the base and outer membrane may engage or be bonded to define a cavity there between, a

sealable passageway defined between adjacent ends of the tubular base and outer membrane in fluid communication with the cavity, and a formable material disposed in the cavity.” At no point does McCall disclose or suggest these elements. Instead, the Examiner simply alleges that the structure of McCall “may” be modified with the claimed elements. This is not a proper basis for an anticipation rejection, which requires the anticipating reference to disclose at least one embodiment that discloses all of the claimed elements. See, for example, C.R. Bard, Inc. v. M3 Systems, 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998)(“[A] finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device”)(emphasis added); In re Bond, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)(“For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference... These elements must be arranged as in the claim under review...”)(emphasis added).

Because McCall does not disclose each of the elements recited by the claims at issue, it follows that the claims are not anticipated thereby. In addition, McCall fails to disclose or suggest that it would be desirable or even possible to provide a writing element having a grip with a sealable passageway formed between adjacent ends of a tubular base and outer membrane that communicates with a cavity, and hence a prima facie case of obviousness has not been established. See In re Sernaker, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985).

The Office action further rejects claims 55-58, 60, 62, and 63 under 35 U.S.C. 103(a) as obvious over McCall. As noted directly above, McCall fails to disclose or suggest the desirability or possibility to provide a grip with the sealable passageway, and therefore the obviousness rejection must be withdrawn.

CONCLUSION

It is submitted that the present application is in good and proper form for allowance.
A favorable action on the part of the Examiner is respectfully solicited.

If, in the opinion of the Examiner a telephone conference would expedite prosecution
of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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May 24, 2005

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